

### **REMARKS**

In view of the following Remarks, the Examiner is requested to withdraw the rejection and allow Claims 1-8, 13, 17, and 27, the only claims pending and currently under examination in this application.

#### **FORMAL MATTERS:**

Claims 1 and 13 are amended. Support for these amendments may be found throughout the specification, at for example page 7, lines 1-2.

No new matter is added. As such, the Examiner is requested to enter the above amendments.

#### **CLAIM OBJECTIONS:**

The Examiner asserts that the claims recited non-elected subject matter, specifically, nucleic acids encoding SEQ ID NO: 2, 6, 8, 10, 12, 14 and 18, and that non-elected subject matter must be removed from the claims prior to allowance of the elected invention.

Applicants submit that they elected Group II with traverse in response to the Restriction Requirement mailed April 23, 2008. That restriction requirement set forth Group II, the limitations of this group being set forth in the excerpt of that Restriction Requirement provided below:

Group II, claim(s) 1-8,12-13, 1-8,12-13,17-18, drawn to a nucleic acid encoding ppGFP2 including those encoding variants as set forth in SEQ ID NO:4,18,20,22,24,26 and 28 and a cell, in vitro, comprising said nucleic acid.

In keeping with this restriction requirement, Applicants have amended Claim 1 to remove SEQ ID NOs: 2, 6, 8, 10, 12, 14, and **16, not 18**, as requested by the Examiner. In view of this amendment, this objection may be withdrawn.

#### **REJECTIONS UNDER §112, ¶1**

The Examiner asserts that the claims encompass variants of a nucleic acid encoding an inactive fluorescent protein, but one of skill in the art would not know how to use the claimed nucleic acids encoding inactive fluorescent proteins. (p. 3, l. 5-7). The Examiner asserts that “an active limitation, such as ‘wherein the protein encoded by the nucleic acid exhibits fluorescence’ is necessary to limit the claim to functional, fluorescing variants.” The Examiner asserts that the limitation should be reiterated in claim 13. (p. 3, l. 13-15)

The Applicants have amended claims 1 and 13 to recite that the protein encoded by the nucleic acid exhibits fluorescence.

In view of this amendment, reconsideration and withdrawal of the rejection is requested.

**CONCLUSION**

Applicant submits that all of the claims are in condition for allowance, which action is requested. If the Examiner finds that a telephone conference would expedite the prosecution of this application, please telephone the undersigned at the number provided.

The Commissioner is hereby authorized to charge any underpayment of fees associated with this communication, including any necessary fees for extensions of time, or credit any overpayment to Deposit Account No. 50-0815, order number EURE-005.

Respectfully submitted,  
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